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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/632,749	08/01/2003	Hiroyuki Azuma	NEC 03P101	4659
27667	7590	07/27/2006	EXAMINER	
HAYES, SOLOWAY P.C. 3450 E. SUNRISE DRIVE, SUITE 140 TUCSON, AZ 85718				RIVERO, ALEJANDRO
		ART UNIT		PAPER NUMBER
		2618		

DATE MAILED: 07/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/632,749	AZUMA, HIROYUKI
	Examiner Alejandro Rivero	Art Unit 2618

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 11 May 2006.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-19 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-19 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 11 May 2006 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____	6) <input type="checkbox"/> Other: _____

## **Response to Amendment**

### ***Response to Arguments***

1. Applicant's arguments filed 5/11/2006, regarding claims 1-15, have been fully considered but they are not persuasive. Applicant's arguments with respect to claims 16-19 have been considered but are moot in view of the new ground(s) of rejection.
2. Applicant argues that Simpson et al. do not teach "an external module that collects information from a mobile communications terminal and stores the data collected" because they teach pre-programming the module with data and uploading it to the mobile communications terminal. However, the examiner respectfully disagrees because after the module is installed, it may be modified by the user in order to customize the operation of the terminal (see column 6 lines 48-68, column 7 lines 1-2, where Simpson et al. disclose customizing the operation (information relating to the internal state) of the mobile to his personal preference and storing the customizing data, hence the data is collected)

### ***Specification***

3. The examiner accepts the changes made to the specification in order to overcome the objections to the specification of the previous Office Action. However, applicant has included additional changes that are not clear to the examiner. The following changes submitted by the applicant are objected: amendment of the paragraph beginning at page 16 (line 10), amendment of the paragraph beginning at page 16 (line 22), amendment of the paragraph beginning at page 17 (line 7), amendment of the paragraph beginning at page 17 (line 17), amendment of the

paragraph beginning at page 18 (line 1), amendment of the paragraph beginning at page 18 (line 24), amendment of the paragraph beginning at page 19 (line 11), amendment of the paragraph beginning at page 19 (line 23), amendment of the paragraph beginning at page 20 (line 1), amendment of the paragraph beginning at page 20 (line 15), amendment of the paragraph beginning at page 20 (line 25), amendment of the paragraph beginning at page 21 (line 10) and amendment of the paragraph beginning at page 21 (line 15).

4. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. The following title is suggested: METHOD FOR TESTING COMMUNICATION PROTOCOL HAVING COLLECTION OF INTERNAL INFORMATION OF A MOBILE COMMUNICATION TERMINAL BY AN EXTERNAL MODULE.

*Drawings*

5. The examiner accepts the changes made to the drawings in order to overcome the objections of the previous Office Action.

*Claim Rejections - 35 USC § 102*

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –  
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Simpson et al. (US 5,404,580).

Consider claim 1, Simpson et al. disclose an external module (smart card) for installation into a mobile communication terminal (Abstract, column 4 lines 49-52), said external module comprising; a collection mechanism (keypad interface) for communicating with said mobile communication terminal to collect information relating to the internal state of said mobile communication terminal (Column 6 lines 48-68, column 7 lines 1-2, where Simpson et al. disclose customizing the operation (information relating to the internal state) of the mobile to his personal preference and storing the customizing data, hence the data is collected); and a storage mechanism for storing therein information that has been collected by said collection mechanism (Column 6 lines 48-68, column 7 lines 1-2, figure 3 element 132).

Consider claim 8, Simpson et al. disclose a mobile communication terminal in which an external module is installed (Abstract, column 4 lines 49-52), said mobile communication terminal comprising: an acquisition mechanism (keypad) for acquiring information relating to the internal state of said mobile communication terminal (Column 6 lines 48-68, column 7 lines 1-2, where Simpson et al. disclose customizing the operation (information relating to the internal state) of the mobile to his personal preference and storing the customizing data, hence the data is acquired by the mobile terminal); and an output mechanism (keypad interface and microprocessor) for supplying information that has been acquired by said acquisition mechanism to said external module (Column 6 lines 48-68, column 7 lines 1-2, figure 3 element 122).

Consider claim 9, Simpson et al. disclose a mobile communication system comprising: a mobile communication terminal (Abstract); and an external module for

installation into said mobile communication terminal (Abstract, column 4 lines 49-52); wherein said mobile communication terminal comprises: an acquisition mechanism (keypad) for acquiring information relating to the internal state of said mobile communication terminal (Column 6 lines 48-68, column 7 lines 1-2, where Simpson et al. disclose customizing the operation (information relating to the internal state) of the mobile to his personal preference and storing the customizing data, hence the data is acquired by the mobile terminal); an output mechanism (keypad interface and microprocessor) for supplying information that has been acquired by said acquisition means to said external module (Column 6 lines 48-68, column 7 lines 1-2, figure 3 element 122); and wherein said external module comprises: a collection mechanism for collecting information that has been supplied by said output mechanism of said mobile communication terminal (Column 6 lines 48-68, column 7 lines 1-2); and a storage mechanism for storing therein information that has been collected by said collection means (Column 6 lines 48-68, column 7 lines 1-2, figure 3 element 132).

Consider claim 10, Simpson et al. disclose a method for testing communication protocol in a mobile communication terminal (Column 1 lines 16-30, column 2 lines 65-68, column 3 lines 1-4), an external module being installed into said mobile communication terminal (Abstract, column 4 lines 49-52), said method comprising steps of: requesting said mobile communication terminal, by said external module, to execute a communication protocol sequence (Column 4 lines 53-56, where Simpson et al. describe a registration request); executing, by said mobile communication terminal, said communication protocol sequence in accordance with said request by said external

module (Column 4 lines 56-57, where Simpson et al. disclose a registered subscriber); acquiring, by said mobile communication terminal (keypad), information relating to the internal state of said mobile communication terminal (Column 6 lines 48-68, column 7 lines 1-2); supplying, by said mobile communication terminal (microprocessor), the acquired information to said external module (Column 6 lines 48-68, column 7 lines 1-2, figure 3 element 122); collecting, by said external module, information that has been supplied by said mobile communication terminal (Column 6 lines 48-68, column 7 lines 1-2); and storing, in said external module, the collected information (Column 6 lines 48-68, column 7 lines 1-2, figure 3 element 132).

Consider claims 2, 3 and 11, Simpson et al. disclose all the limitations as applied to claims 1 and 10 above and also disclose protocol execution mechanism for requesting said mobile communication terminal to execute a communication protocol sequence (Column 4 lines 53-56, where Simpson et al. describe a registration request, reads on claim 2) and protocol execution mechanism includes a mechanism for requesting the execution of said communication protocol sequence based on information that has been stored in said storage mechanism (Column 4 lines 53-56, where Simpson et al. disclose a subscriber validation code, reads on claim 3) and wherein said step of requesting to execute a communication protocol sequence includes requesting, by said external module to execute said communication protocol sequence based on information that is stored (Column 4 lines 53-56, where Simpson et al. disclose a subscriber validation code, reads on claim 11).

Consider claims 4 and 12, Simpson et al. disclose all the limitations as applied to claims 2 and 10 above and also disclose wherein said communication protocol sequence is a communication protocol sequence that is performed by radio between a mobile communication terminal and a base station (Column 4 lines 53-56, reads on claim 4) and wherein said step of executing a communication protocol sequence includes execution by said mobile communication terminal of a communication protocol sequence by radio with a base station (Column 4 lines 53-56, reads on claim 12).

Consider claims 5 and 13, Simpson et al. disclose all the limitations as applied to claims 1 and 10 above and also disclose stored information processing mechanism (microprocessor) for processing information that has been stored in said storage mechanism (Column 4 lines 49-56, reads on claim 5) and processing information that is stored in said external module (Column 4 lines 49-56, reads on claim 13).

Consider claims 6 and 14, Simpson et al. disclose all the limitations as applied to claims 5 and 13 above and also disclose wherein said protocol execution mechanism includes a mechanism for requesting the execution of a communication protocol sequence (registration) based on information (subscriber validation code) that has been processed by said stored information processing means (Column 4 lines 53-57, reads on claim 6) and wherein said step of executing a communication protocol sequence includes requesting, by said external module, execution of a communication protocol sequence (registration) based on information (subscriber validation code) that has been processed (Column 4 lines 53-57, reads on claim 14).

Consider claims 7 and 15, Simpson et al. disclose all the limitations as applied to claims 1 and 10 above and also disclose wherein said external module is any one of a SIM card (smart card), a USIM card, and an IC card having higher specifications than a SIM card or USIM card (Abstract, reads on claims 7 and 15).

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. Claims 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Simpson et al. in view of Rimpelä et al. (US 6,697,604 B1).

Consider claim 16, Simpson et al. disclose an external module for installation in a mobile communication terminal (Abstract, column 4 lines 49-52), said external module comprising; a test program execution unit for performing test programs (Column 1 lines 16-30, column 2 lines 65-68, column 3 lines 1-4, where Simpson et al. disclose enhancing a service card); a collection mechanism for communicating with said mobile

communication terminal to collect information relating to the internal state of said mobile communication terminal (Column 6 lines 48-68, column 7 lines 1-2) and a storage mechanism for storing therein information that has been collected by said collection mechanism (Column 6 lines 48-68, column 7 lines 1-2, figure 3 element 132).

However, Simpson et al. do not disclose collecting during execution of test programs on said test program execution unit.

Rimpelä et al. disclose collecting during execution of test programs on said test program execution unit (Abstract, column 6 lines 26-36, column 8 lines 53-63, column 10 line 46-column 11 line 12, where Rimpelä et al. disclose running tests on a control block).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to collect information during execution of test programs on the test program execution unit, as taught by Rimpelä et al., in the method of Simpson et al. for the purpose determining and controlling delays, data to be transmitted and desired functions of the mobile station (as suggested by Rimpelä et al. in column 5 lines 33-45).

Consider claim 17, Simpson et al. disclose a mobile communication terminal in which an external module for executing test programs is installed (Abstract, column 4 lines 49-52), said mobile terminal comprising: an acquisition mechanism for acquiring information relating to the internal state of said mobile communication terminal (Column 6 lines 48-68, column 7 lines 1-2, where Simpson et al. disclose customizing the operation (information relating to the internal state)); and an output mechanism for

supplying information that has been acquired by said acquisition mechanism to said external module (Column 6 lines 48-68, column 7 lines 1-2, figure 3 element 122).

However, Simpson et al. do not specifically disclose acquiring during said test programs.

Rimpelä et al. disclose acquiring information during the test programs (Abstract, column 6 lines 26-36, column 8 lines 53-63, column 10 line 46-column 11 line 12, where Rimpelä et al. disclose running tests on a control block).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to acquire information during the test programs, as taught by Rimpelä et al., in the method of Simpson et al. for the purpose determining and controlling delays, data to be transmitted and desired functions of the mobile station (as suggested by Rimpelä et al. in column 5 lines 33-45).

Consider claim 18, Simpson et al. disclose a mobile communication system comprising a mobile communication terminal; and an external module for installation in said mobile communication terminal (Abstract, column 4 lines 49-52); wherein said mobile communication terminal comprises: an acquisition mechanism for acquiring information relating to the internal state of said mobile communication terminal (Column 6 lines 48-68, column 7 lines 1-2, where Simpson et al. disclose customizing the operation (information relating to the internal state)); and an output mechanism for supplying information that has been acquired by said acquisition mechanism to said external module (Column 6 lines 48-68, column 7 lines 1-2, figure 3 element 122); and wherein said external module comprises: a test program execution unit for performing

test programs (Column 1 lines 16-30, column 2 lines 65-68, column 3 lines 1-4); a collection mechanism for collecting information that has been supplied by said output mechanism of said mobile communication terminal (Column 6 lines 48-68, column 7 lines 1-2); and a storage mechanism for storing therein information that has been collected by said collection means (Column 6 lines 48-68, column 7 lines 1-2, figure 3 element 132).

However, Simpson et al. do not specifically disclose collecting information for test programs on said test program execution unit.

Rimpelä et al. disclose collecting information for test programs on said test program execution unit (Abstract, column 6 lines 26-36, column 8 lines 53-63, column 10 line 46-column 11 line 12, where Rimpelä et al. disclose running tests on a control block).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to collect information for test programs, as taught by Rimpelä et al., in the method of Simpson et al. for the purpose determining and controlling delays, data to be transmitted and desired functions of the mobile station (as suggested by Rimpelä et al. in column 5 lines 33-45).

Consider claim 19, Simpson et al. disclose a method for testing communication protocol by executing test programs in a mobile communication terminal (Column 1 lines 16-30, column 2 lines 65-68, column 3 lines 1-4), an external module being installed in said mobile communication terminal (Abstract, column 4 lines 49-52), said method comprising steps of: requesting said mobile communication terminal, by said

external module, to execute a communication protocol sequence (Column 4 lines 53-57); executing, by said mobile communication terminal, said communication protocol sequence in accordance with said request by said external module (Column 4 lines 53-57); acquiring, by said mobile communication terminal, information relating to the internal state of said mobile communication terminal (Column 6 lines 48-68, column 7 lines 1-2, where Simpson et al. disclose customizing the operation (information relating to the internal state)); supplying, by said mobile communication terminal, the acquired information to said external module (Column 6 lines 48-68, column 7 lines 1-2, where Simpson et al. disclose customizing the operation (information relating to the internal state) and this information is stored on the SIM card); collecting, by said external module, information that has been supplied by said mobile communication terminal as part of said test program (Column 6 lines 48-68, column 7 lines 1-2); and storing, in said external module, the collected information from said test program (Column 6 lines 48-68, column 7 lines 1-2, figure 3 element 132).

However, Simpson et al. do not specifically disclose collecting information for test programs.

Rimpelä et al. disclose collecting information for test programs (Abstract, column 6 lines 26-36, column 8 lines 53-63, column 10 line 46-column 11 line 12, where Rimpelä et al. disclose running tests on a control block).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to collect information for test programs, as taught by Rimpelä et al., in the method of Simpson et al. for the purpose determining and controlling delays, data

to be transmitted and desired functions of the mobile station (as suggested by Rimpelä et al. in column 5 lines 33-45).

***Conclusion***

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Staber (US 6,430,410 B1) disclose a test facility and test method for monitoring of GSM network services.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alejandro Rivero whose telephone number is (571) 272-2839. The examiner can normally be reached M-F, 8:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nay Maung can be reached on (571) 272-7882. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Q.B.V



7/24/06

QUOCHIEN B. VUONG  
PRIMARY EXAMINER